

## **REMARKS**

The Office Action dated November 3, 2006 has been carefully considered. Claim 25 is pending and claims 1-24 and 26-44 are withdrawn. Reconsideration and allowance of the present application in view of the following remarks are respectfully requested.

### **I. CLAIMS**

In the Office Action, the Examiner has indicated that claim 25 is the only pending claim in the application and claims 1-24 and 26-44 are withdrawn in response to Applicant's Response to Restriction Requirement, dated October 6, 2006, in which Applicant elected claim 25 (invention II) for examination. However, in the Restriction Requirement dated September 18, 2006, the Examiner indicated that claims 1-23 and 26, as originally filed, link inventions I (claim 24) and II (claim 25). (Restriction Requirement, page 4). Pursuant to MPEP § 809, "linking claims must be examined with, and thus are considered part of, the invention elected." MPEP § 809, Eighth Edition, Revision 5.

Accordingly, it is respectfully submitted that linking claims 1-23 and 26, as originally filed, should be examined with elected invention II (pending claim 25).<sup>1</sup> MPEP § 809. Thus, it is also respectfully submitted that claims 1-23 and 26 were improperly withdrawn in the November 3, 2006 Office Action.

### **II. INFORMATION DISCLOSURE STATEMENT**

As requested by the Examiner, Applicant resubmits herewith a copy of the Information Disclosure Statement ("IDS") and List of References that were originally submitted with the present application on October 20, 2003. It is believed that no fee is due for the resubmission of these documents at this time. However, if a fee is due, please charge such fee to Jones Day Deposit Account No. 50-3013.

### **III. CLAIM REJECTION**

Claim 25 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,211,384 to Pagedas ("Pagedas") in view of U.S. Patent No. 5,008,110 to Benecke *et al.* ("Benecke"). Applicant respectfully disagrees.

Claim 25 is directed to a method of delivering a drug through a patient's skin comprising: (a) providing a transdermal delivery system that comprises a plurality of patch

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<sup>1</sup> Claims 27 and 28 were not addressed in the Restriction Requirement, but it is believed that claim 28 should also be examined with currently pending claim 25 and claims 1-23 and 26.

units, wherein each patch unit comprises a backing layer having one or more borders, a drug layer comprising buprenorphine disposed on the backing layer, and an adhesive layer, wherein at least a portion of the adhesive layer is disposed on the borders of the backing layer; the plurality of patch units are connected to each other along one or more borders of the patch units; and each patch unit is defined by one or more lines of separation along the borders of the patch units; (b) separating at least one patch unit from the transdermal delivery system along at least one line of separation; and (c) applying at least one patch unit such that the drug layer makes contact with the skin.

Pagedas does not teach or suggest a method of delivering a drug through a patient's skin as recited in claim 25. Specifically, Pagedas does not teach or suggest a drug layer disposed on a backing layer and an adhesive layer disposed on the borders of the backing layer, as required in claim 25. Further, as acknowledged by the Examiner, Pagedas does not disclose or suggest buprenorphine, as recited in claim 25. Office Action, page 4.

Benecke does not remedy the deficiencies of Pagedas. Benecke also does not teach or suggest a patch unit having a drug layer disposed on a backing layer and a portion of an adhesive layer disposed on the borders of the backing layer, as recited in claim 25. In fact, Benecke does not even disclose or suggest a drug layer disposed on a backing layer. Furthermore, Benecke does not disclose or suggest a plurality of patch units that are connected to each other along one or more borders of the patch units, wherein each patch unit is defined by one or more lines of separation along the borders of the patch units, and the step of separating at least one patch unit from the transdermal delivery system along at least one line of separation, as required by claim 25.

For the above reasons, Applicant respectfully submits that there is no suggestion or motivation to modify or combine the teachings of Pagedas and Benecke to obtain the method of claim 25. Also, since both references fail to disclose or suggest a drug layer disposed on a backing layer and an adhesive layer disposed on the borders of the backing layer, it is believed that claim 25 is patentable over Pagedas in view of Benecke. Accordingly, withdrawal of this rejection and allowance of claim 25 are respectfully requested.

For reasons discussed above, it is believed that claims 1-23 and 26 are also patentable over the references cited herein.

#### IV. CONCLUSION

Thus, as the claim rejection is believed to be overcome, the pending claim is believed to be in condition for allowance. Reconsideration and allowance of the present application are respectfully requested. An early notice to that effect would be appreciated. Should the Examiner not agree with Applicant's position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

Respectfully submitted,

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Enclosure